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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/665,984	09/19/2003	Christopher McGee	020375-042800US	5376

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EXAMINER

FUREMAN, JARED

ART UNIT	PAPER NUMBER
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2876

MAIL DATE	DELIVERY MODE
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05/03/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/665,984

Applicant(s)

MCGEE ET AL.

Examiner

Jared J. Fureman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 February 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9, 12, 15-20, 23-31, 33-36, 41-50, 67 and 74-78 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 67 and 74-78 is/are allowed.
- 6) ☒ Claim(s) 1-9, 12, 15-20, 23-31, 33-36 and 41-50 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 September 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Receipt is acknowledged of the amendment, filed on 2/8/2007, which has been entered in the file. Claims 1-9, 12, 15-20, 23-31, 33-36, 41-50, 67 and 74-78 are pending.

Drawings

1. Figures 1A and 1B should be designated by a legend such as --Prior Art-- because only that which is old is illustrated (see paragraphs 21, 32 and 33 of the specification, which describe figures 1A and 1B as conventional cards). See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

3. Claims 23, 24, 26, 28-30 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yen (US 2002/0066789 A1, previously cited) in view of Fujimoto (US 2004/0080784 A1, previously cited).

Re claims 23, 24, 26, 28, 29 and 35: Yen teaches a financial presentation instrument with an integrated holder comprising: a rectangular shaped data card (substrate 10, figures 1-5) having an information storage medium (value added chip 15, figure 3; magnetic strip 16, figure 4; bar code 17, figure 5; for example) that is configured to store a unique identifier (a credit card, personal identification card, or bank card, see paragraph 22, will store a unique identifier) and at least one aperture (central hole 11, figure 1 and paragraph 17) therethrough for suspending the data card from a display hook (the central hole 11, as shown in figures 1-4, is clearly capable of suspending the data card from a display hook, therefore this functional limitation does not structurally define applicant's invention over Yen), wherein the at least one aperture

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is located on a central portion of the data card (see central hole 11, figures 1-5), wherein the data card further comprises a back side with the information storage medium located thereon (the side shown in figures 3-5 can be considered a back side), a front side (the side shown in figure 1 can be considered a front side), and the aperture (central hole 11) is at least $1/16$ of an inch from outside edges of the card and the information storage medium (see figures 1-5); wherein the aperture comprises a circular shape (the central hole 11 is circular, see figures 1-5); wherein the data card comprises a stored value card (a telephone card, public transportation ticket, bank card, etc., represented a stored value, see paragraphs 21 and 22); wherein the information storage medium comprises a magnetic stripe (magnetic strip 16, figure 4 and paragraph 22); wherein the information storage medium comprises a bar code (bar code 17, figure 5 and paragraph 23); (also see figures 1-5, paragraphs 7, 16, 17, 19-24).

Yen fails to specifically teach a live copy limit that is about $3/32$ of an inch from outside edges of the card; the aperture being at least $1/16$ of an inch from the live copy limit.

Fujimoto teaches providing a data card with a live copy limit (a safety margin, the difference between disposition allowable region 41 and print securing region 40, see figure 12 and paragraph 50) that is about $3/32$ of an inch from outside edges of the card (0.5 mm per side is within $3/32$ of an inch) (also see figures 12, 14, 17A, 17B, paragraphs 50 and 86-89). Since Fujimoto teaches the live copy limit (the safety margin) being around the edges of the card and Yen teaches the aperture being in the

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center of the card, the combination of Yen and Fujimoto will result in the aperture being at least about $1/16$ of an inch from the live copy limit.

In view of Fujimoto's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the data card as taught by Yen, a live copy limit that is about $3/32$ of an inch from outside edges of the card; the aperture being at least $1/16$ of an inch from the live copy limit; in order to ensure that there is no lack of printing due to print deviation errors (see paragraph 50, of Fujimoto).

Re claim 30: The teachings of Yen as modified by Fujimoto have been discussed above. Yen also teaches that the data card comprises a credit card (see paragraph 22).

Yen fails to specifically state wherein the card has dimensions that are about $2 \frac{1}{8}$ inches by about $3 \frac{3}{8}$ inches.

However, at the time of the invention it was old and well known to those of ordinary skill in the art that a standard credit card has dimensions that are about $2 \frac{1}{8}$ inches by about $3 \frac{3}{8}$ inches.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the data card as taught by Yen as modified by Fujimoto, wherein the card has dimensions that are about $2 \frac{1}{8}$ inches by about $3 \frac{3}{8}$ inches; in order for the card to be compatible with standard credit card readers, thereby eliminating the need for a specialized credit card reader and the inherent costs associated therewith.

6. Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yen as modified by Fujimoto and further in view of Duroj (US 2002/0006103 A1, previously cited).

The teachings of Yen as modified by Fujimoto have been discussed above.

Yen as modified by Fujimoto fails to specifically teach an additional aperture through the data card.

Duroj teaches a data card (card 1, figure 1) comprising an aperture (3, figures 1-3) located on a central portion of the data card and an additional aperture (8, figure 3) through the data card (see figures 1-3, paragraphs 7, 12, 13, 18 and 20).

In view of Duroj's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the data card as taught by Yen as modified by Fujimoto, an additional aperture through the data card; in order to allow the data card to be attached to a carrying device or the like (see paragraph 20, of Duroj).

7. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yen as modified by Fujimoto and further in view of the admitted prior art.

The teachings of Yen as modified by Fujimoto have been discussed above.

Yen as modified by Fujimoto fails to specifically teach wherein the data card comprises a gift card.

The admitted prior art teaches that gift cards were old and well known to those of ordinary skill in the art at the time of the invention (see paragraph 2 of applicant's specification).

In view of the admitted prior art, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the data card as taught by Yen as modified by Fujimoto, wherein the data card comprises a gift card; in order to increase demand and sales of the data card by allowing the data card to function as a gift card. Furthermore, the data card comprising a gift card represents an intended use of the data card, which fails to structurally define applicant's invention over Yen as modified by Fujimoto (for example, the structure of Yen is capable of functioning as a gift card).

8. Claims 31, 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Blank (US 7,032,817, previously cited) in view of Fujimoto.

Blank teaches a financial presentation instrument (transaction card assembly 1, figure 4) with an integrated holder comprising: a data card having a circular shaped portion (the auxiliary portion 20 in figure 4) and a rectangular shaped bottom portion (the card portion 10 in figure 4) having an information storage medium (while not shown in figure 4, Blank teaches that the card portion 10 includes an information storage media, see column 2, lines 12-15; column 5, lines 38-44; column 6, lines 34-41; and column 7, lines 20-25) that is configured to store a unique identifier (a credit card number and/or account number, see column 6, lines 34-41, will be a unique identifier) and at least one centrally spaced aperture (figure 4 shows the card assembly 1 having an aperture centrally spaced in auxiliary portion 20) therethrough for suspending the data card from a display hook (the aperture, as shown in figure 4, is clearly capable of

suspending the data card from a display hook, therefore this functional limitation does not structurally define applicant's invention over Blank), wherein the rectangular shaped bottom portion has the information storage medium displayed thereon (see column 2, lines 12-15; column 6, lines 34-41; and column 7, lines 20-25) and the diameter of the circular shaped portion is less than a longest length of the rectangular shaped bottom portion (see figure 4); wherein the data card comprises a stored value card (see column 2, lines 47-49); wherein the data card comprises a gift card (see column 2, lines 47-49) (also see column 1, lines 18-20; column 2, lines 12-15, 47-53; column 5, lines 38-45, 55-63; column 6, lines 34-41; column 7, lines 20-25; and column 8, lines 32-41).

Blank fails to specifically teach wherein a live copy limit is located on the front or back side of the card at about $\frac{3}{32}$ of an inch from the bottom and both side portions of the rectangular shaped bottom portion.

The teachings of Fujimoto have been discussed above.

In view of Fujimoto's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the data card as taught by Blank, wherein a live copy limit is located on the front or back side of the card at about $\frac{3}{32}$ of an inch from the bottom and both side portions of the rectangular shaped bottom portion, in order to ensure that there is no lack of printing due to print deviation errors (see paragraph 50, of Fujimoto).

9. Claims 1-9, 12, 15-20, 36, 41-50, 67 and 74-78 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yen as modified by Fujimoto and further in view of Biller (US 2004/0182940 A1, previously cited).

Re claims 1, 3-9, 12, 15-20, 36, 41, 42 and 45-50: The teachings of Yen as modified by Fujimoto have been discussed above. Yen also teaches the data card (substrate 10) comprising top and bottom flat portions and two side flat portions (see figures 1-5); regarding the claimed $3 \frac{3}{8}$ inches long by $2 \frac{1}{8}$ inches long, see Yen as modified by Fujimoto as applied to claim 30 above. Note that in applying Yen as modified by Fujimoto to claims 12-16, the central hole 11 can be considered an additional aperture, the additional aperture being circular.

Yen as modified by Fujimoto fails to specifically teach at least one J-peg shaped aperture; an additional aperture through the data card; wherein the data card comprises a gift card; a method for displaying a financial presentation instrument with an integrated holder comprising: providing a display hook and suspending the data card from the display hook through the at least one aperture; wherein the aperture is located on a top portion of the data card; wherein the aperture is located on a side portion of the data card.

Biller teaches a data card (120, figure 3) comprising a J-peg shaped aperture (display hole 80, figure 3) therethrough for suspending the data card from a display hook (not shown, see paragraph 38); wherein the data card comprises a gift card (see paragraphs 2 and 5); and a method for displaying a financial presentation instrument with an integrated holder comprising: providing a display hook (not shown) and

suspending the data card from the display hook through the at least one aperture (see paragraph 38); wherein the aperture is located on a top portion of the data card (see figure 3); wherein the aperture is located on a side portion of the data card (the top of the card is also one of the sides of the card, see figure 3). Note that Biller teaches/suggests the apertures are spaced from the edges of the card, thus the combination of Yen as modified by Fujimoto and Biller still suggests the aperture(s) being 1/16 of an inch from each other, the live copy limit and the information storage medium.

In view of Biller's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the data card as taught by Yen as modified by Fujimoto, at least one J-peg shaped aperture; an additional aperture through the data card; wherein the data card comprises a gift card; a method for displaying a financial presentation instrument with an integrated holder comprising: providing a display hook and suspending the data card from the display hook through the at least one aperture; wherein the aperture is located on a top portion of the data card; wherein the aperture is located on a side portion of the data card; in order to allow a more stable mounting of the data card, using the J-peg shape, on display hooks.

Re claims 2, 43 and 44: The teachings of Yen as modified by Fujimoto and Biller have been discussed above. Biller also teaches the aperture located on a top portion of the data card.

Yen as modified by Fujimoto and Biller fails to specifically teach providing an additional display hook and suspending the data card from the additional display hook

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through the additional aperture; wherein the pair of apertures are located on a top portion of the data card.

However, at the time of the invention it was old and well known to those of ordinary skill in the art to display retail products by hanging the products from two (or more) display hooks through corresponding apertures.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the data card and method as taught by Yen as modified by Fujimoto and Biller, providing an additional display hook and suspending the data card from the additional display hook through the additional aperture; wherein the pair of apertures are located on a top portion of the data card; in order to provide a more stable mounting of the data card to the display.

Allowable Subject Matter

4. Claims 67 and 74-78 have been allowed over the prior art of record.
5. The following is an examiner's statement of reasons for allowance: The prior art of record, taken alone or in combination, fails to teach or fairly suggest: (re claim 67 and dependents) a data card comprising a top edge comprising two flat portions on either side of a protrusion portion and at least one aperture through the protrusion for suspending the data card from a display hook; in combination with the other claimed limitations as set forth in claim 67.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably

accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Response to Arguments

6. Applicant's arguments filed 2/8/2007, regarding claims 1-9, 12, 15-20, 23-31, 33-36 and 41-50 have been fully considered but they are not persuasive.

Applicants argue that the office action appears to equate the "safety margin" of Fujimoto with the copy limit of the claims, however, applicants contend that a copy limit differs from a "safety margin" (see the third paragraph on page 10 of the amendment filed on 2/8/2007). It is noted that applicants have not made any effort to explain why the safety margin of Fujimoto can not be considered a live copy limit. Fujimoto's safety margin is used to prevent print position errors from affecting the printed image (see paragraph 50 of Fujimoto). Thus, it appears as though Fujimoto's safety margin performs the same function as applicants live copy limit.

Applicants argue that the claimed live copy limit is 5 times larger than Fujimoto's safety margin (see the third paragraph on page 10 of the amendment filed on 2/8/2007). As discussed above, Fujimoto's safety margin performs the same function as applicants live copy limit. Applicants have not provided any evidence that the claimed dimensions are critical or that the claimed dimensions provide any unexpected results. In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the

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claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. Thus, since Fujimoto's safety margin provides the same function/result as applicant's live copy limit, Fujimoto meets the claimed limitation.

The examiner also notes that applicants describe their figures 1A and 1B as conventional cards and state that live copy limit 20 should fall at least 3/32 of an inch within the standard credit card dimensions (see paragraph 32 of the specification). **Thus, it appears as though applicants are merely claiming a conventional live copy limit.**

Applicants argue that nothing in figure 3 of Biller suggests the J-peg shaped aperture is located on one of the two side portions of the data card (see the bottom of page 10 of the amendment filed on 2/8/2007). Biller is relied upon to teach the use of a J-peg shaped aperture, not the size of the card. The size of the card had been previously addressed, see Yen as modified by Fujimoto as applied to claim 30. Thus, it is the combination of references that teach/suggest the claimed invention.

Applicants argue that Blank seems to show a diameter that is the same length as the diameter of the bottom portion of the card, not less than the length of the rectangular shaped bottom portion (see applicant's arguments regarding claim 31 on page 11 of the amendment filed on 2/8/2007). It is noted that applicants do not claim where the diameter is being measured. A common definition of a diameter is the length of a straight line through the center of an object. Thus, the diameter could be measured at any point of the circular shaped portion that passes through the center. Figure 4 of

Blank shows a circular shaped auxiliary portion 20 and a rectangular shaped bottom card portion 10. The circular shaped auxiliary portion 20 and rectangular shaped bottom card portion 10 intersect at a line of weakness 2. If the diameter were measured from the top of the circular shaped auxiliary portion 20 to the line of weakness 2, as it can be argued that this is where the circular shaped auxiliary portion 20 ends, the diameter will be less than a longest length of the rectangular shaped bottom card portion 10.

Applicants argue that the limitation of a rectangular shaped aperture appears to be absent from Yen, Fujimoto and Biller (see applicant's arguments regarding claims 35 and 36 on page 11 of the amendment filed on 2/8/2007). However, in figure 1, Biller shows an aperture 80 that is roughly a rectangular shape. Thus, the combination of references teaches/suggests the claimed invention.

Applicants argue that claim 1 recites that each aperture is at least about 1/16 of an inch from the live copy limit (see the bottom of page 11 of the amendment filed 2/8/2007). As shown in their respective drawings, Yen and Biller suggest that all of the apertures are located a sufficient distance from the edge of the cards that when combining the live copy limit/safety margin as taught by Fujimoto, the apertures will be at least 1/16 of an inch from the live copy limit. Again, it is noted that applicants have not shown any criticality of the claimed dimensions or shown that the claimed dimensions produce any unexpected results. Thus, the combination of references teaches/suggests the claimed invention.

In addition, applicants are reminded that functional language (for example, “for suspending the data card from a display hook”, as recited in independent claims 1, 12, 23, 31, 35 and 67) does not define the invention over the prior art, when the prior art discloses the claimed structural limitations and is capable of performing the recited function (see MPEP 2114). In this case, the apertures of Yen, Duroj and Blank are capable of suspending the data card from a display hook.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jared J. Fureman whose telephone number is (571) 272-2391. The examiner can normally be reached on 8:00 am - 5:30 PM M-T, and every other Friday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Jared J. Fureman
Primary Examiner
Art Unit 2876

April 30, 2007